126-128 under 35 U.S.C. § 103(a) as being unpatentable over Hartman and Yamada in view of Holland (U.S. Patent No. 6,493,742); rejected claim 39 under 35 U.S.C. § 103(a) as being unpatentable over Hartman and Yamada in view of Polnerow (U.S. Patent No. 5,813,006); and rejected claims 107, 123 and 125 under 35 U.S.C. § 103(a) as being unpatentable over Hartman and Yamada and Holland in view of an Official Notice of obviousness.

Applicants hereby amend claims 1, 10, 13, 29, 31, 32, 33, 37, 40, 41, 50, 51, 52, 56, 59, 64 and 68 in order to clarify the subject matter of their invention. Applicants further hereby cancel claims 11-12, 28, 34, 39, 42-49, 66 and 69-128 to simplify pending issues and expedite issuance of a patent. Thus, claims 1-10, 13-27, 29-33, 35-38, 40-41, 50-65, 67-68 and 129 are now pending.

Analysis

Objection To Specification

The Examiner has objected to the specification for failing to include a Summary of the Invention section. Although permissible, it is not required to include a Summary of the Invention section in a specification. "A brief summary of the invention . . . should precede the detailed description. Such summary should, when set forth . . ." 37 C.F.R. § 1.73. The "should" and "when set forth" language clearly indicates that the Summary of the Invention section is optional. In contrast, the Code of Federal Regulations uses unambiguous imperative language to make clear which sections of the specification are mandatory. For example, "the specification must include a written description," and "the specification must conclude with a claim." 37 C.F.R. § 1.71, 1.75. Based upon the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw the pending objection.

Obviousness-Type Double Patenting Rejection

The Examiner has also rejected claim 39 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of co-pending Patent Application No. 09/151,617, as well as under 35 U.S.C. § 103(a) as being unpatentable over Hartman and Yamada in view of Polnerow. However, these rejections are mooted since claim 39 is no longer pending in the application.

<u>Prior Art Rejections</u>

The Examiner has rejected all of the other pending claims under 35 U.S.C. § 103(a) as being unpatentable over a combination of Hartman and Yamada, either alone or in combination with Holland or with Holland and one or multiple Official Notices of obviousness. However, the pending claims as rejected included features and provided functionality not disclosed by any of these references, and the pending claims as amended further clarify various patentable aspects of the pending claims. Thus, each of the pending claims is allowable.

<u>Lack Of Motivation To Combine</u>

As a threshold matter, each of the pending claims, both as rejected and as amended, is patentable over the cited prior art because the Examiner has not provided sufficient motivation to combine the teachings of the Hartman and Yamada references. The Examiner's only argument in this regard is that combining these disparate techniques "would allow the user the novelty and convenience to order items online for different destinations for him and/or gifts for individuals other than him." (Office Action dated January 10, 2003, page 5.) However, Hartman already described functionality that allowed a user to order items to be sent to different delivery addresses and to others as gifts, such as via a standard shopping cart model of ordering items. Among other places, the following passages from Hartman describe related existing techniques:

> The World Wide Web is especially conducive to conducting electronic commerce. . . . When the user has completed selecting the items to be purchased, *the server computer system then prompts the user for* information to complete the ordering of the items. This purchaser-specific order information may include the purchaser's name, the purchaser's credit card number, and *a shipping address for the order*. . . . The selection of the various items from the electronic catalogs is generally based on the "shopping cart" model. When the purchaser selects an item from the electronic catalog, the server computer system metaphorically adds that item to a shopping cart. When the purchaser is done selecting items, then all the items in the shopping cart are "checked out" (i.e., ordered) when the purchaser provides billing and shipment information.
> Hartman, 1:46-2:24 (emphasis added).

Thus, the Examiner's stated motivation does not apply, because Hartman already possessed the functionality described by the Examiner as the basis for the motivation to combine.

Moreover, even if Hartman had lacked the functionality described by the Examiner as the basis for the motivation to combine, the Examiner has provided no motivation that Hartman be modified in the described manner other than based on hindsight construction from the inventive functionality described in Applicants' application. According to the Manual of Patent Examining Procedure ("MPEP") and controlling caselaw, the motivation to combine references cannot be based on mere common knowledge and common sense as to benefits that would result from such a combination, and instead must be based on specific teachings in the prior art, such as a specific suggestion in a prior art reference. For example, last year the Federal Circuit rejected an argument by the PTO's Board of Patent Appeals and Interferences that an ability to combine the teachings of two prior art references to produce beneficial results would be sufficient motivation to combine them, and overturned the Board's finding of obviousness because of the failure to provide a specific motivation in the prior art to combine the two prior art references.[1] The MPEP provides similar instructions to those mandated by the Federal Circuit.[2]

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[1]

The Nortrup reference describes a television set having a menu display by which the user can adjust various picture and audio functions; however, the Nortrup display does not include a demonstration of how to adjust the functions. The Thunderchopper Handbook describes the Thunderchopper game's video display as having a "demonstration mode" showing how to play the game . . . Lee appealed to the Board, arguing that . . . the prior art provided no teaching or motivation or suggestion to combine this reference [Thunderchopper] with Nortrup . . . On the matter of motivation to combine the Nortrup and Thunderchopper references, . . . review of the Examiner's Answer reveals that the examiner merely stated that both the Nortrup function menu and the Thunderchopper demonstration mode are program features and that the Thunderchopper mode "is user-friendly" and it functions as a tutorial, and that it would have been obvious to combine them.

When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., . . . In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("'teachings of references can be combined only if there is some suggestion or incentive to do so.'") (emphasis in original) (quoting ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)). . . .

Conversely, and in a similar manner to the arguments rejected by the Federal Circuit, the Examiner's motivation to combine these two prior art references is based solely on the alleged beneficial results that would result from combining them, with no motivation from the prior art cited to support the combination. Thus, if the Examiner maintains the current rejection on the basis of the above reasoning, Applicants request that the Examiner explain with the required specificity where the Examiner finds a suggestion or motivation in the references for this combination.

Lack Of Recited Features In The Cited Prior Art

Moreover, even if a motivation to combine the Hartman and Yamada references did exist, Applicants' pending claims recite features and provide functionality not disclosed or suggested by those or the other cited references.

For example, independent claim 1 as amended recites using "multiple groups of order fulfillment information that are each predefined for the user and that each include a unique combination of a delivery address, shipping instructions distinct from the delivery address, and a payment source" and that "after selection by the user of a displayed indication of one of the identified multiple groups and without further intervention by the user," a request to order the item is sent "such that the identified item is to be sent to the delivery address for the selected indicated group using the shipping instructions for the selected indicated group and is to be paid for by the payment source for the selected indicated group".

With respect to Lee's application, neither the examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described. The examiner's conclusory statements . . . do not adequately address the issue of motivation to combine.
In re Sang-Su Lee, In re Sang-Su Lee, 277 F.3d 1338, at 1341-1343, (Fed. Cir. 2002).

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To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).
Manual of Patent Examining Procedure, § 2143 (emphasis added).

Conversely, a combination of Hartman and Yamada would not provide any of these recited features. The Examiner has noted in the prior Office Action that, while Hartman discloses single-action ordering to a single defined delivery address for a user, Hartman does not teach that a user has multiple defined procurement options having information related to ordering items, nor does Hartman teach the displaying of multiple such procurement options during the ordering of an item. The Examiner has instead cited Yamada in support of having multiple such procurement options that are defined for a single user and that are displayed in such a way as to facilitate single-action ordering using any of those procurement options. However, Yamada merely discloses that multiple possible *delivery addresses* can be defined and then displayed to a user who is considering ordering an item, and that multiple additional steps are required after a delivery address is selected to complete the item ordering (*e.g.*, in a manner analogous to a virtual shopping cart). (Yamada, Figures 9-12 and 4:50-5:7.) Yamada makes no reference to defining types of information other than delivery addresses for users, nor to performing ordering of items in any way that is analogous to single-action ordering, and the Examiner has not cited any such teaching or suggestion.

Thus, even if the techniques of Yamada were combined with Hartman, the resulting system would provide a user with (at most) single-action ordering to a single defined delivery address, and multiple delivery addresses that the user could use in conjunction with shopping cart-based ordering or other multi-step ordering. The Examiner has provided no explanation why the Hartman/Yamada combination would instead result in the recited multiple groups of order fulfillment information for a user "that each include a unique combination of a delivery address, shipping instructions distinct from the delivery address, and a payment source," nor how the multiple delivery addresses of Yamada could be used to allow ordering of an item "without further intervention by the user" after one of the order fulfillment information groups is selected.

Moreover, each of the other pending claims as amended recites one or more such features that would not be described or suggested in a possible Hartman/Yamada combination. For example, independent claim 9 as rejected similarly recites using

multiple groups of predefined order fulfillment information "each including a delivery address, shipping instructions, and a payment source" and requesting an ordered item "without further intervention by the user" after one of the groups is selected. Claim 9 is thus patentable over the cited prior art resources for at least the same reasons as for claim 1.

Independent claim 10 as amended similarly recites using multiple procurement options defined for a user "that each have a distinct combination of information that is sufficient to complete an order for the identified item, the combination of information for each defined procurement option including multiple types of information that include at least payment information and delivery information" such that after a procurement option is selected "the payment information for that procurement option will be used to pay for the identified item and such that the delivery information for that procurement option will be used for delivery of the identified item", and independent claims 29, 31, 32, 33, 40, 41, 50, 56 and 59 as amended each recite similar language. As noted above, however, any Hartman/Yamada combination would not include multiple procurement options as recited that each include payment and delivery information and each can be used for ordering items, and thus these claims are similarly patentable over these prior art references.

Independent claim 64 similarly recites displaying indications of multiple defined procurement options for use in ordering an item, and further recites that the requesting of the item ordering occurs "in response to selection of a displayed indication by a user and without further intervention by the user", and independent claims 67 and 68 recite similar language. As noted above, however, any Hartman/Yamada combination would not include multiple procurement options that could be used to order an item such that selection of an option by a user would cause the item to be ordered without further intervention by the user, and thus these claims are similarly patentable over these prior art references.

In addition, the pending dependent claims include the features of those claims from which they depend, and are thus allowable for the same reasons as those claims. Moreover, the pending dependent claims also recite additional features lacking in the cited references, and are thus allowable on the basis of those features as well,

although these various additional features are not enumerated here due to the allowability of these claims for the other reasons already described above. Applicants do note, however, that some of the pending claims recite creating and using new procurement options as part of the item ordering process, such that such newly defined procurement options are available for later use in ordering other items. While the Examiner has asserted that Hartman discloses such functionality, the cited portions of Hartman (Fig. 1B and 4:59-5:8) are unrelated to such functionality, and instead discuss an ability to change an order for an item that has been ordered using single-action ordering, such as to allow canceling of the order for a predefined amount of time after the order was placed.

Applicants also note that the Examiner has used multiple Official Notices of obviousness to provide the basis for rejecting several of these dependent claims, including that of "providing a default program while working on the computers when several choices are available to the user to select one", that of "sending a message with the supplied item as a gift", and that "all purchases online are subject to a specified cost threshold such that the purchase value does not exceed the credit value available to the user". While Applicants agree that defaults and gift messages and credit limits have been used generally in the prior art, Applicants do not agree that it is obvious to use such techniques in the manner recited in the claims for which the Official Notices have been cited. Thus, if the Examiner maintains these rejections in the next Office Action, Applicants request that the Examiner cite references in support of his positions pursuant to MPEP 2144.03 and the PTO's memo on "Procedures for Relying on Facts Which are Not of Record as Common Knowledge or for Taking Official Notice" dated February 21, 2002.
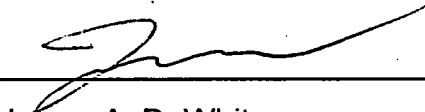
Conclusion

In light of the above remarks, Applicants respectfully submit that all of the pending claims are allowable. Applicants therefore respectfully request the Examiner to reconsider this application and timely allow all pending claims.

Moreover, if the Examiner decides to maintain the current rejections, Applicants request that the Examiner contact the Applicants' representative at (206) 583-8888

before the issuance of the next Office Action. Similarly, the Examiner is encouraged to contact the Applicants' representative to discuss any other issues or distinctions between the claims and the applied references, if so desired.

Respectfully submitted,

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APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims:

1. (Twice Amended) A method for a user at a client system to place an order for an item, the user having a plurality of groups of predefined order fulfillment information, the method comprising:

displaying at the client system information identifying the item;

displaying at the client system an element representing order fulfillment instructions for the identified item;

receiving indications of multiple groups of ~~predefined~~ order fulfillment information <u>that are each predefined for the user and that</u> each includ<u>e</u>~~ing~~ a <u>unique combination of a</u> delivery address, shipping instructions<u> distinct from the delivery address</u>, and a payment source;

when the displayed element is selected by the user, displaying at the client system an indication of each of the identified multiple groups; and

after selection by the user of a displayed indication of one of the identified multiple groups and without further intervention by the user, sending to a server computer a request to order the identified item such that the identified item is to be sent to the delivery address for the selected indicated group using the shipping instructions for the selected indicated group and is to be paid for by the payment source for the selected indicated group,

so that a single action of selecting a group of order fulfillment information orders and pays for the item.

10. (Amended) A method for <u>assisting a user in </u>ordering an item using a client system, the method comprising:

displaying information identifying the item;

for each of multiple procurement options ~~having~~ defined for that user that each have a distinct combination of information that is sufficient to complete an order for the identified item, the combination of information for each defined procurement option including multiple types of information that include at least payment information and delivery information, ~~related to ordering,~~ displaying an indication of the procurement option such that selection of the displayed indication represents using the information of the procurement option for ordering of the identified item; and

after selection of a displayed indication, sending to a server system a request to order the identified item using the information of the procurement option for the selected indication such that the payment information for that procurement option will be used to pay for the identified item and such that the delivery information for that procurement option will be used for delivery of the identified item.

13.   (Amended) The method of claim 10 wherein the delivery information of the procurement option for the selected indication includes shipping instructions, and wherein the sent request is additionally to deliver the identified item as specified by the shipping instructions.

29.   (Twice Amended) A computer-readable medium whose contents cause a computer system to order an item using a client system, by performing a method comprising:

displaying information identifying the item;

for each of multiple procurement options that each have~~ing~~ information related to ordering that includes at least delivery information and information regarding payment, displaying an indication of the procurement option such that selection of the displayed indication represents using the information of the procurement option for ordering of the identified item; and

after selection of a displayed indication, sending to a server system a request to order the identified item using the information of the procurement option for the selected indication.

31. (Twice Amended) A client system for ordering an item comprising:

a display component able to display information identifying the item and able to display, for each of multiple procurement options having ~~sufficient~~ information that includes at least payment information and delivery information and that is sufficient to complete an order for the identified item, an indication of the procurement option such that selection of the displayed indication represents using the information of the procurement option for ordering of the identified item; and

an item ordering component able to, after selection of a displayed indication, send to a server system a request to order the identified item using the information of the procurement option for the selected indication.

32. (Twice Amended) A client system for ordering an item comprising:

means for displaying information identifying the item and for displaying, for each of multiple procurement options having ~~sufficient~~ information that is sufficient to complete an order for the identified item and that includes at least payment information and delivery information, an indication of the procurement option such that selection of the displayed indication represents using the information of the procurement option for ordering of the identified item; and

means for, after selection of a displayed indication, sending to a server system a request to order the identified item using the information of the procurement option for the selected indication.

33. (Twice Amended) A method for a server system to process an order for an item, the method comprising:

sending to a client system an indication of an item that may be ordered;

sending to the client system an indication of multiple procurement options that are all associated with a single user of the client system and that each ~~having~~ a distinct combination of associated information ~~for~~ that is sufficient to complet~~ing~~ an order for the identified item, the associated information for each procurement option stored on the server system and including at least payment information and delivery information for a specified recipient; and

after receiving an indication from the client system to order the identified item using a selected one of the multiple procurement options and without further intervention by the client system,

retrieving the stored associated information for the selected procurement option; and

_____requesting delivery of the identified item to a the recipient specified by the selected procurement option, the delivering of and payment for the identified item in a manner specified by the selected procurement option.

37.   (Twice Amended) The method of claim 33 wherein the a selected procurement option is an indication that a new procurement option is to be created and used, and including receiving delivery information for the new procurement option and creating the new procurement option to include the received delivery information.

40.   (Twice Amended) A computer-readable medium whose contents cause a computer system to process an order for an item, by performing a method comprising:

sending to a client system an indication of an item that may be ordered;

sending to the client system an indication of multiple procurement options that each haveing associated information for completing an order for the identified item that includes at least payment information and delivery information; and

after receiving an indication from the client system to order the identified item using a selected one of the multiple procurement options and without further intervention by the client system, requesting delivery of the identified item to a recipient specified by the selected procurement option, the delivering in a manner specified by the selected procurement option.

41.   (Twice Amended) A server system for processing an order for an item comprising:

a sending component able to send to a client system an indication of an item that may be ordered and able to send to the client system an indication of multiple procurement options each having associated information for completing an order for

the identified item that includes at least payment information and delivery information for a recipient; and

a receiving component able to receive from the client system an indication that one of the multiple procurement options was selected and able to, after receiving an indication to order the identified item from the client system and without further intervention by the client system, deliver the identified item to a recipient specified by the selected procurement option in a manner specified by the selected procurement option.

50. (Twice Amended) A computer-readable medium containing a data structure for use in ordering an item, the data structure comprising:

a plurality of indications of multiple procurement options each having a distinct combination of sufficient information that is sufficient to complete an order for an item and that includes at least payment source information and delivery information, so that a user can perform a selection of the indication of one of the procurement options to indicate to use the information of the procurement option when ordering the item such that the payment source information for the procurement option will be used for payment and the delivery information for the procurement option will be used for delivery.

51. (Twice Amended) The computer-readable medium of claim 50 wherein each procurement option further includes a delivery address, shipping instructions, and a payment source.

52. (Twice Amended) The computer-readable medium of claim 50 wherein all of the procurement options are associated with a single user and wherein each of the procurement options is a unique combination of delivery and payment information for a single the user.

56. (Twice Amended) A display device for displaying a visual representation of a data structure stored in memory, the visual representation including an indication

of an item to be ordered and at least one indication of a control that is selectable by a user, each control representing one of a plurality of multiple procurement options that each have~~ing~~ sufficient information to complete an order for the item that includes at least payment source information and delivery information,

so that a user can order the item using the information of a procurement option represented by a control after selecting the indication for the control such that the payment source information for the procurement option will be used for payment and the delivery information for the procurement option will be used for delivery.

59. (Twice Amended) A computer-readable medium containing a data structure having information for display, the information when displayed including an indication of an item to be ordered and at least one indication of a control that is selectable by a user, each control representing one of a plurality of multiple procurement options that each have~~ing~~ sufficient information to complete an order for the item that includes at least payment source information and delivery information,

so that a user can order the item using the information of a procurement option represented by a control after selecting the displayed indication for the control.

64. (Twice Amended) A method for ordering an item using a client system, the method comprising:

displaying information identifying the item;

for each of multiple procurement options having information related to ordering, displaying an indication of the procurement option such that selection of the displayed indication represents an ordering of the identified item using the information of the procurement option; and

in response to selection of a displayed indication by a user and without further intervention by the user, sending to a server system a request to order the identified item using the information of the procurement option for the selected indication.

68. (Twice Amended) A computer system for assisting a user in ordering an item, comprising:

a display component capable of displaying information identifying the item and of, in response to an indication received from the user, displaying an indication for each of multiple procurement options associated with the user that have sufficient information related to complete an ordering for the identified item, the displayed indications such that selection of one of the displayed indications represents an instruction to order the identified item using the information of the procurement option associated with the selected indication; and

an item ordering component capable of, in response to selection of a displayed indication and without further intervention, sending to a server system a request to order the identified item using the information of the procurement option associated with the selected indication.